

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims is less than previously filed.

Claim Objections/Amendments

Claim 1 has been amended to clarify the claimed structure. Support for this Amendment can be found in FIGS. 1 and 2, and the description thereof.

Claims 24 and 36 have been amended to correct claim dependencies, thereby rendering the claim objection moot.

Claims 24 and 38 have been amended to further describe the claimed invention. Claim 42 has been added. Support for this Amendment can be found at page 12, second paragraph of the Substitute Specification.

Claim 25 has been amended to clarify the claimed invention. Support for this Amendment can be found, for example, at page 8, last paragraph, and in FIGS. 1, 7, and 9, and the description thereof.

No new matter has been added to the claims by this Amendment.

Claim Rejections - 35 U.S.C. §103

The rejection of Claims 1, 36, 40, and 41 under 35 U.S.C. §103(a) as being obvious over Schut et al., DE 10044771 (machine translation), in view of Ahern et al., GB 2159386, is respectfully traversed.

Schut et al. discloses narrow incisions 6 formed in the mouthpiece case 1 to create paper strips (which appear to be similar to the grooves/teeth discussed at page 8, second paragraph, of the Substitute Specification). The Office Action agrees that Schut et al. does not disclose or suggest Applicants' deformed part recited in Claim 1.

In Figs. 11 and 12, Ahern et al. discloses two transverse slits 316 that provide a portion 318 that is displaced inwardly (page 4, lines 102-108). As shown in Fig. 12, the displaced portion 318 does not include an end edge of the mouthpiece that extends across the cavity and contact the opposing inner side wall of the second cavity. The portion 318 of Ahern et al. is disposed back from, and does not include any portion of, an end edge of any mouthpiece. Neither Ahern et al. nor the combination provides the limitations of amended Claim 1. As the combination does not provide all claim limitations, the rejection of Claims 1, 36, 40, and 41 should be withdrawn.

The rejection of Claims 21, 25, and 35 under 35 U.S.C. §103(a) as being unpatentable over Schut et al., DE 10044771, in view of Ahern et al., GB

2159386, and further in view of Labarre, U.S. Patent 905,715, is respectfully traversed.

The purported motivation for adding the perforated structure of Labarre is identified in Ahern et al.'s teaching that additional structures can be included. However, in Claim 21, the deformed part (5) of the wall includes the perforations. According to the alleged combination, the deflected portion 318 of Ahern et al. would not be perforated, but instead a separate structure would be added. Adding perforations to the portion 318 of Ahern et al. would not reasonably provide any benefit, as the perforations would face the wrong way. The combination as alleged does not provide the claim limitations of Claim 21 as actually recited.

Labarre is applied for disclosing a perforated diaphragm. Labarre discloses a rigid perforated plate to be hung within a tobacco pipe, useful for supporting tobacco away from the mouthpiece. The Office Action alleges it would have been obvious to use the perforated plate in the paper cigarette of Shut et al., but no reasonable explanation on how the non-paper perforated plate of the Labarre can be implemented in the paper cigarette of Shut et al. is provided.

The combination does not provide or suggest the following limitations of amended Claim 25: 1) the empty mouthpiece formed of a material that is more rigid than a material forming the envelop; 2) an entire length of the empty envelope overlapping the empty mouthpiece; and 3) a separating partition disposed

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at a position within the mouthpiece that is also within the envelope both when the empty envelope overlaps the empty mouthpiece and is in a displaced configuration.

As the combination does not provide all limitations of Claim 25, the rejection of Claim 25 should be withdrawn. Favorable reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of Claims 25 and 35 under 35 U.S.C. §103(a) as being obvious over Schut et al., DE 10044771 (machine translation), in view of Arneson, U.S. Patent 2,542,612, is respectfully traversed.

The combination does not provide or suggest the following limitations of amended Claim 25: 1) the empty mouthpiece formed of a material that is more rigid than a material forming the envelop; 2) an entire length of the empty envelope overlapping the empty mouthpiece; and 3) a separating partition disposed at a position within the mouthpiece that is also within the envelope both when the empty envelope overlaps the empty mouthpiece and is in a displaced configuration.

Also, there is no basis in the combination for one of ordinary skill in the art to construct a paper cigarette with the Arneson filters at a position within both the mouthpiece and the envelope, as required by Applicants' claimed invention. The Arneson filters are housed in a separate attachment at an end of the cigarette mouthpiece.

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As the combination does not provide all limitations of Claim 25, the rejection of Claims 25 and 35 should be withdrawn. Favorable reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of Claims 24, 37, and 38 under 35 U.S.C. §103(a) as being unpatentable over Schut et al., DE 10044771, in view of Ahern et al., GB 2159386, and further in view of Labarre, U.S. Patent 905,715, and Mentzel et al., DE 4107025, is respectfully traversed.

Claims 24, 37, and 38 are patentable for at least the same reasons discussed for the independent claims.

The Examiner explained by telephone that the second Labarre reference on page 7 should have been Mentzel et al. Mentzel et al. does not appear to provide the recited spacing insert, and clarification of this rejection is respectfully requested if the rejection is to be maintained. New Claim 42 also includes limitations not provided by the alleged combination, as best understood.

Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney requests a telephone interview with the Examiner.

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Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,



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